UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,675	10/02/2000	Frank Hagebarth	Q60673	4764

7590 03/03/2005		EXAMINER
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Avenue, N.W. Washington, DC 20037-3213		SEFCHECK, GREGORY B

ART UNIT	PAPER NUMBER
2662	

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/676,675	HAGEBARTH, FRANK
	Examiner	Art Unit
	Gregory B Sefcheck	2662

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 December 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5 and 8-26</u> is/are rejected.

7)☒ Claim(s) <u>6 and 7</u> is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>02 April 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

- Applicant's Request for Continued Examination filed 12/9/2004 is acknowledged.

- Claims 20-26 are newly added.

- Claims 1-26 remain pending.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims 1-5, 8-11, and 23 are rejected under 35 U.S.C. 102(b) as being

anticipated by McMullin (US005809128A).

- In regards to Claim 1,

McMullin discloses a method of activating an inactive terminal of a data network

characterized by the following steps: establishing a connection to a server of the data

network (a caller, wishing to call a network subscriber, establishes a connection from

the callers terminal to a proxy (see items 44a and 38 of figure 38)) and transmitting an

identifier of the terminal to be activated to the server of the data network (the

subscribers number is sent to the proxy (see figures 2 and 3)), receiving the identifier at

the server of the data network (the proxy receives the subscribers number (see figures

2 and 3)), interpreting the identifier at the server of the data network to determine the

telephone number of the terminal be activated (the proxy performs a DNIS/ANI lookup,

thus it has interpreted the number it receives from the caller (see figures 2 and 3));

making a call from the server of the data network through the telephone network to the

terminal to be activated (the server calls the subscriber through the PSTN (see figures 2

and 3:, signaling the identity of the server of the data network through the telephone

network to the terminal to be activated (the proxy communicates to the subscriber's

computer using IP packets which have source addresses and these packets are sent

through the PSTN to the subscriber (see figure 2 and column 6)), receiving the

telephone call and interpreting the signaling at the terminal be activated (the subscriber

receives a notification from the proxy (see figure 2 and columns 10 and 11)), terminating

the telephone call to the terminal by the server of the data network (the proxy sends the

notifications and signaling to the subscriber (see figure 2 and columns 10 and 11)) and

establishing a connection from the terminal to be activated to the data network if the

signaling indicates that the telephone call came from a server of the data network (the

subscriber is notified of the incoming call from the server and the subscriber can accept

the call and establish communication with the caller through the use of the subscribers

PC (see figure 2 and columns 10 and 11);

- In regards to Claim 2,

McMullin discloses a method of activating an inactive terminal of a data network

that covers all limitations of the parent claim.

The establishment of the connection to the server of the data network and the transmission of the identifier of the terminal to be activated the server of the data network are effected by the further terminal (the caller makes a call to the subscriber using the subscribers phone number (see figure 2 and column 6));

- In regards to Claim 3,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

In order to establish a connection between the further terminal and the terminal to be activated, McMullin discloses that the terminal to be activated establishes a connection to a server of the data network (when the subscriber decides to communicate with the caller the subscriber indicates so to the proxy (see figure 2 and columns 10 and 11)) and transmits its identifier to the server or the identifier is determined by the server (the subscriber transmits IP paçkets to the proxy which have source addresses in them (see figure 2 and columns 10 and 11)), the data network addresses of the two terminals are transmitted by the server of the data network to the respective other terminal or are retrieved by the terminals from the server (1P packets have both source and destination addresses in them (see figure 2 and columns 10 and 11), and connection is established by the terminals through the telephone network and the data network (a connection between the subscriber and the caller is established (see columns 10 and 11).

- In regards to Claim 4,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

The data network in McMullin is designed as an Internet Protocol network (the data network is an the Internet (see column 6)).

- In regards to Claim 5,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

The further terminal of McMullin is a calling party's terminal connected to a telephone network (the caller has a terminal connected to the PSTN (see figure 2)) and in that the terminal to be activated is a called party's terminal connected to the telephone network (the subscribers computer is connected to the PSTN (see figure 2)) the called party's terminal being activated to set up a voice call between the calling party's terminal and the called party's terminal through the IP network (the subscriber sets up a connection with the caller through the Internet (see figure 2 and columns 10 and 11)).

- In regards to Claim 8,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

McMullin discloses a server of a data network (a proxy server of a data network (see figure 2; characterized by means for receiving from a terminal an identifier of a terminal to be activated, which connected to a telephone network (the proxy receives a phone number of a subscriber connected to the PSTN and to whom a caller wishes to contact (see figure 2 and column 6)) means for making a telephone call over the telephone network to the terminal to be activated (the proxy contacts the subscriber through the PSTN (see figure 2)) and means for terminating the telephone call to the terminal to be activated (the proxy can terminate the call by the caller in various ways, such as voice mail functions (see figure 2 and Page 6 columns 10 and 11)).

- In regards to Claim 9,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

The server of McMullin is designed as an access server in an IP network (the proxy can be implemented in the Internet and serves to provide access to a subscriber by the caller (see figure 2 and columns 10 and 11)).

- In regards to Claim 10,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

The server of McMullin further comprising means for interpreting the identifier and determining the telephone number of the terminal to be activated (the proxy interprets the subscribers number entered by the caller in order to perform a look-up function (see figure 3)).

- In regards to Claim 11,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

The server of McMullin further comprises means for accepting a telephone call received from the terminal over the telephone network and means for establishing a connection from the terminal the data network (the proxy comprises means for implementing calls from the subscriber to the caller that traverse through the PSTN and Internet (see figure 2 and columns 10 and 11)).

- In regards to Claim 23,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

McMullin discloses that the subscriber could decide to disconnect from the telephone link to free up for incoming calls, at which point a connection could be established, such as through the data network (Col. 10-11, lines 65-8; claim 23 – connection from the terminal to be activated is established after terminating the telephone call to the terminal by the server of the data network).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 12-19, 22, and 24-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over McMullin in view of Rahikainen et al. (US006085080A), hereafter

Rahikainen.

-      In regards to Claim 12 and 15, 16, 18, and 19,

McMullin discloses an adapter unit characterized by means for establishing a

connection from the terminal to a server of a data network over the telephone network

(the subscriber using his or her computer can establish a connection to the proxy

through the PSTN (see figure 2 and columns 10 and 11)), means for receiving a

telephone call of a server of the data network (the proxy connects a call with the

subscribers computer (see figure 2 and columns 10 and 11)), means for interpreting a

number of a caller (the callers number is displayed to the subscriber by the subscribers

computer (see figure 2 and columns 10 and 11)), means for retrieving and/or receiving a

data network address of a further adapter unit of the caller from the server of the data

network (the proxy sends the subscriber the phone number of

the caller (see figure 2 and columns 10 and 11)) and means for establishing a data call

to the further adapter unit through the data network (the subscriber uses his or her

computer to establish a call with the caller (see figure 2 and columns 2 and 3)).

regarding claim 17, McMullin discloses the microcomputer as a personal computer (see

figures 1 and 2).

McMullin does not disclose comparing caller and server telephone numbers in

order to determine whether to accept or reject the call.

Rahikainen discloses a system wherein the telephone numbers of incoming calls

are compared to numbers on a restricted list and a determination is made as to whether

to accept or reject the associated incoming calls (see column 5, lines 7-39).

It would have been obvious to one skilled in the art at the time of the invention to

implement this feature in the McMullin system because as Rahikainen points out, in

column 2 lines 30-41, such a feature would make the system more user-friendly and

flexible by allowing users of the system to selectively restrict and/or reject calls from

taking place.

-    In regards to Claims 13 and 14,

McMullin discloses a method of activating an inactive terminal of a data network

that covers all limitations of the parent claim.

Furthermore, McMullin discloses means for transmitting the identifier of a

terminal to be activated or the identification of a called party to the server of the data

network (the caller sends the phone number of the subscriber he or she is trying to call

to the proxy and also the subscriber, when he or she decides to communicate with the

caller through the computer, sends the callers address to the proxy in an IP packet so

that the proxy knows where to send the packet when it is received (see figure 2 and

columns 10 and 11)).

McMullin shows implementation as a processor, a memory, an interface to the

telephone network and an interface to an Internet Protocol (IP) network (the subscribers

computer has a processor, a memory and interfaces to the PSTN and Internet (see

figure 2 and columns 10 and 11)).

- In regards to Claim 17,

McMullin discloses a method of activating an inactive terminal of a data network

that covers all limitations of the parent claim.

McMullin discloses the microcomputer as a personal computer (see figures 1-2).

- In regards to Claim 22,

McMullin discloses a method of activating an inactive terminal of a data network

that covers all limitations of the parent claim.

McMullin does not explicitly disclose the terminal to be activated as having not

yet established a connection through the data network. Specifically, the method of

McMullin is disclosed for when the terminal's telephone link is using the link for

connecting to a data network.

However, the method of McMullin would be applicable when the terminal's

telephone link is being used for any other use, such as another telephone call, and

would not necessarily require the link being used in a data network connection to be

viable.

It would have been obvious to one of ordinary skill in the art at the time of the

invention to implement the method of McMullin for when the telephone link of the called

terminal is being used for another telephone call and has yet been connected to a data

network. The method of McMullin would be applicable regardless of how the telephone

link is being utilized when the incoming call signaling is received.

- In regards to Claim 24-26,

McMullin discloses a method of activating an inactive terminal of a data network

that covers all limitations of the parent claim.

Referring to Fig. 2, McMullin discloses the functionality of the adapter to be within

the subscriber's premises 28, between the subscriber and the telephone network (claim

24,26 – adapter unit is connected between a terminal of the telephone network and the

telephone network; claim 25 – adapter is incorporated in the telephone).

5.   Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMullin.

- In regards to Claim 20 and 21,

McMullin discloses a method of activating an inactive terminal of a data network that covers all limitations of the parent claim.

McMullin does not explicitly disclose the terminal to be activated as having not yet established a connection through the data network. Specifically, the method of McMullin is disclosed for when the terminal's telephone link is using the link for connecting to a data network.

However, the method of McMullin would be applicable when the terminal's telephone link is being used for any other use, such as another telephone call, and would not necessarily require the link to be engaged in a data network connection at the time of the received incoming call signalling to be viable.

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement the method of McMullin for when the telephone link of the called terminal is being used for another telephone call and has yet been connected to a data network. The method of McMullin would be applicable when an incoming call is received as the telephone link is being used in another telephone call rather than a data network connection.

Allowable Subject Matter

6.   Claims 6 and 7 are objected to as being dependent upon a rejected base claim,

but would be allowable if rewritten in independent form including all of the limitations of

the base claim and any intervening claims.

-    In regards to Claim 6,

The prior art of record does not teach or fairly suggest a method of activating

an inactive terminal of a data network in which a VoIP adapter of a called

party prevents an incoming call from being transferred from an identified VoIP

server to the called terminal until a connection from the called VoIP adapter to

a POP server is made and the IP addresses of the calling and called VoIP

adapters are received and an IP connection between the adapters is made.

Response to Arguments

7.   Applicant's arguments with respect to claims 20-26 have been considered but are

moot in view of the new ground(s) of rejection.

-    Applicant has not provided arguments with respect to claims 1-19 in the

Amendment filed 12/9/2004.

-    Arguments filed 10/18/2004 were responded to in the Advisory Action

mailed 11/22/2004.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory B Sefcheck whose telephone number is 571-272-3098. The examiner can normally be reached on Monday-Friday, 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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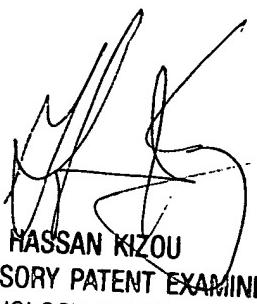
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